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STEPHEN E. REITER
PRETTY, SCHROEDER, BRUEGGEMANN & CLARK
444 SOUTH FLOWER STREET - SUITE 2000
LOS ANGELES, CALIFORNIA 90071

HILM, I EXAMINER	
ART UNIT	PAPER NUMBER
1812	19

DATE MAILED: 11/15/95

Below is a communication from the EXAMINER in charge of this application

COMMISSIONER OF PATENTS AND TRADEMARKS

ADVISORY ACTION

☐ THE PERIOD FOR RESPONSE:

a) ☐ is extended to run _____ or continues to run _____ from the date of the final rejection

b) ☐ expires three months from the date of the final rejection or as of the mailing date of this Advisory Action, whichever is later. In no event however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition , and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

☑ Appellant's Brief is due in accordance with 37 CFR 1.192(a).

☑ Applicant's response to the final rejection, filed 10/30/95 has been considered with the following effect, but it is not deemed to place the application in condition for allowance:

1. ☑ The proposed amendments to the claim and /or specification will not be entered and the final rejection stands because:

   a. ☐ There is no convincing showing under 37 CFR 1.116(b) why the proposed amendment is necessary and was not earlier presented.

   b. ☐ They raise new issues that would require further consideration and/or search. (See Note).

   c. ☐ They raise the issue of new matter. (See Note).

   d. ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.

   e. ☑ They present additional claims without cancelling a corresponding number of finally rejected claims.

   NOTE: _____

2. ☐ Newly proposed or amended claims _____ would be allowed if submitted in a separately filed amendment cancelling the non-allowable claims.

3. ☑ Upon the filing an appeal, the proposed amendment ☐ will be entered ☑ will not be entered and the status of the claims will be as follows:

   Claims allowed: None
   Claims objected to: None
   Claims rejected: 53-67, 66-68, 70-75

   However;

   ☑ Applicant's response has overcome the following rejection(s): See attached

4. ☐ The affidavit, exhibit or request for reconsideration has been considered but does not overcome the rejection because _____

5. ☐ The affidavit or exhibit will not be considered because applicant has not shown good and sufficent reasons why it was not earlier presented.

1) Claims 53 to 63, 66 to 68 and 70 to 75 are pending in the instant application. The amendment filed 30 October of 1995 under 37 C.F.R. § 1.116 in response to the final rejection has been considered but is not deemed to place the application in condition for allowance and will not be entered because it presents additional claims without canceling a corresponding number of finally rejected claims.

2) The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3) The proposed amendment to claims 58 and 68 would avoid the objection to these claims for reciting an improper Markush group.

4) Newly proposed claims 79 to 84, if entered, would avoid the rejection under 35 U.S.C. § 112, first paragraph, which has applied to claims 53 to 63, 66 to 68 and 70 to 75 for those reasons of record in Paper Numbers 12 and 15. Applicant's argument that the insertional, deletional and substitutional mutation analysis which would be required of a practitioner to produce the vast majority of the receptor subunits that are encompassed by the instant claims does not constitute undue experimentation is in direct contrast with the legal holdings that were expressly identified in Paper Number 15.

5) The objection to the specification under 35 U.S.C. § 112, first paragraph, as failing to provide an enabling disclosure for the production of a substantially pure human neuronal nicotinic

acetylcholine receptor subunit has been reconsidered in light of Applicant's response in Paper Number 17, filed 30 October of 1995 under 37 C.F.R. § 1.116, and **withdrawn**.

6) Newly proposed claims 76 to 84, if entered, would be rejected along with claims 53, 54, 57 to 63, 66 to 68, 70 and 72 to 75 under 35 U.S.C. § 103 as being unpatentable over the Boulter et al. publication in view of the Grenningloh et al., Schofield et al. and Noda et al. publications for those reasons of record in Paper Numbers 12 and 15. Applicant has provided lengthy arguments that none of the references that have been relied upon, when taken individually, described an isolated DNA or protein of the instant invention. These arguments ignore the fact that the instant rejection was made under 35 U.S.C. § 103 which does not require the disclosure of the claimed invention in any one or combination of references and these arguments fail to address the combination of references. Each of the references cited have been relied upon to provide those elements that were specifically identified in Paper Numbers 12 and 15. Applicant has not shown that any one or more of these references fails to provide those elements for which they are being relied upon.

Applicant's reliance upon court decisions that hold that those parts of prior art references which teach away from the instant invention can not be ignored is misplaced. Applicant has not identified a single passage in the cited references which teach away from the instant invention.

Applicant's argument that the claimed subunit protein possesses those unexpected properties that are identified on page 16 of Paper Number 17 and in the data presented in Table I of the declaration by Edwin C. Johnson under 37 C.F.R. § 1.132 can not be relied upon to support patentability because these differences were not disclosed in the instant specification. Advantages which are not disclosed in the instant specification carry little or no weight in establishing patentability. See M.P.E.P. 716, *In re Lunberg*, 1958, 117 USPQ 190, *Abbott v. Coe*, 1940, 109 F.2d 449, and *In re Rossi*, 1957, 112 USPQ 479.

7) Applicant's arguments filed 30 October of 1995 have been fully considered but they are not deemed to be persuasive.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John D. Ulm at telephone number (703) 308-4008. The examiner can normally be reached on Monday through Friday from 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, G. D. Draper can be reached on (703) 308-4232. The fax phone number for this group is (708) 305-3014.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

John D. Ulm
JOHN ULM
PATENT EXAMINER
GROUP 1800